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~~A. — the bottom portion and middle portion being cylindrical in shape.~~

5. A fire hydrant protective cover and visibility marker according to claim 1, further comprising;

A. the middle portion having middle portion diameter,

I. the middle portion diameter being equal to the bottom portion diameter.

Claims 3 and 4 (canceled).

REMARKS/ARGUMENTS

Reconsideration of the application in view of the above amendment and the following remarks is requested.

The Examiner states that claims 1-5 were rejected under 35 U.S.C. 102(b), as being anticipated by Herberger, German Patent 470,266. Applicant amends claim 1 to clarify what the inventor claims as his invention, including language which clearly demonstrates the patentable subject matter of this application and traverses the rejection on the grounds that Herberger neither claims nor discloses the invention as now set forth in the claims.

The Examiner states that claims 1-5 were rejected under 35 U.S.C. 102(b), as being anticipated by Chadbourne, U.S. Patent 613,652. Applicant amends claim 1 and deletes claims 3 and 4 to clarify what the inventor claims as his invention, including language which clearly demonstrates the patentable subject matter of this application and traverses the rejection on the grounds that Chadbourne neither claims nor discloses the invention as now set forth in the claims.

Finally, the Examiner states that claims 1-5 were rejected under 35 U.S.C. 102(b), as being anticipated by Rausch, German Patent 692,547. Applicant amends claim 1 to clarify what the inventor claims as his invention, including language which clearly demonstrates the patentable subject matter of this application and traverses the rejection

on the grounds that Rausch neither claims nor discloses the invention as now set forth in the claims.

Applicant respectfully traverses each of the Section 102 rejections, noting specifically that none of the cited patents disclose Applicant's novel device for preventing the build up of snow around a fire hydrant and making the fire hydrant visible in snowy conditions, in the manner disclosed in the original specifications and now claimed in the amended claims.

Applicant believes the amended claims now avoid the Examiner's rejections, and requests speedy allowance of the application based upon the factual and legal arguments set forth in detail below.

FACTUAL ARGUMENT

Applicant has invented a Fire Hydrant Protective Cover And Visibility Marker which prevents the build up of snow and other similar materials around the fire hydrant, thereby making the fire hydrant accessible even when there is a deep snow fall, once the protective cover is removed.

In order to accomplish its objective, the protective cover "As per FIG. 2, the preferred embodiment of the fire hydrant protective cover and visibility marker (1) is sized and shaped to be placed over and around a common ground mounted fire hydrant (7). The instant invention being hollow, the interior space (8) of the device completely engulfs the fire hydrant and prevents it from being directly contacted and covered by accumulating snow. Obviously the instant invention must be sufficiently large enough so that it may be placed over the top of, and slid down over the fire hydrant (7) without becoming caught, wedged or entangled by any valves or hose connection portions (9) the fire hydrant may

possess or a radial flange (12) usually present at the base of the fire hydrant and used to attach the hydrant to a buried water line.” *Application*, P 7, Par. 25. Furthermore, it was stated that “[t]he bottom portion diameter (6) should further obviously be great enough to permit the device to be slid over the fire hydrant which is to be protected and allow the device to completely engulf said fire hydrant.” *Application*, P. 8, Par. 26.

It is therefore required, that Applicant’s device must have dimensions such that when placed over the fire hydrant, the entire hydrant is engulfed, from the top of the hydrant all the way down to the radial flange connecting the fire hydrant to the water line. This is no mere design preference, rather, it is required in order for the device to function as intended by the Inventor, and as now clearly stated in the amended claims.

It is furthermore required “that the overall shape of the instant invention includes the cap portion diameter (5) being greater than the bottom portion diameter (6). This accumulated snow (14) will therefore tend not to accumulate too closely around the bottom portion (2), making removal of the instant invention from up and off the fire hydrant it engulfs much easier than if the device were merely cylindrical in shape. It should be quite apparent that by having the cap portion diameter (5) being greater than the bottom portion diameter (2) there will be a snow free area (15) extending radially from and around the instant invention. The snow free area should be approximately as great as the cap portion diameter (5). *Application*, P. 9, par. 29.

Finally, in order to accommodate removal of the device from around a fire hydrant, Applicant included hand purchase areas. "Because the instant invention is essentially mushroom shaped with the cap portion being basically hemispherical, the instant invention may be easily removed from over the fire hydrant by grasping the instant invention under the cap portion at what may be called hand purchase portions (16). That is, the portion of the instant invention on its exterior which is the underside of the cap portion, proximate to where the cap portion merges into the middle portion (3)." *Application*, P. 9, par. 30.

None of the art cited by the Examiner contains all of the elements of the amended claims, arranged in the same fashion, to produce the same result. Nor is there any indication that any of the art would be amenable to modification to produce Applicant's method without first having seen Applicant's device.

Applicant therefore amends claim 1 to contain the limiting language which sets his invention apart from the prior art. Claim 1 is directed to the device having the cap portion being hemispherical in shape, the device being sized and shaped to completely engulf a fire hydrant, and the device having hand purchase areas. Support for this amendment was set forth above.

Each piece of prior art cited by the Examiner will now be considered in turn.

Herberger, German. Pat. No.470,266, Issued July 8, 1927

With reference to the *Herberger* '266 patent, said patent is directed to a utility cover having an openable top portion "a" (which the Examiner found readable on

Applicant's hemispherical cap), a body portion "e" (which the Examiner found readable on Applicant's hollow body) and a lower portion "r" or "e" (which the Examiner found readable on Applicant's bottom portion. *First Office Action*, P. 2, Par. 3.

Review of the elements cited by the Examiner, in light of the amended claims, now demonstrates that Applicant's device is clearly and patentably distinguishable from Herberger. It is now quite apparent that the Herberger device is not intended to engulf the entire device which it covers from above. The diameter of "r" is too small to receive the lower portion of element "p". The device itself is obviously not intended to fulfil the same purpose as Applicant's device in that the Herberger device does not engulf the entire device which it covers from above. The clear intent and utility of the Herberger device is simply to limit access to the uppermost portions of "p".

Furthermore, given that the Herberger '266 device cannot completely engulf "P", it cannot prevent the buildup of snow around the base of "P", a clearly stated objective of Applicant's invention. "[T]here will be a snow free area (15) extending radially from and around the instant invention. The snow free area should be approximately as great as the cap portion diameter (5)." *Application*, P. 9, par. 29. This defect in Herberger '266 cannot be overcome without modifying the device to engulf all of "P", and there is no reason to make such a change unless one has first seen Applicant's device.

Given the clarification of what Applicant considers to be his invention, Applicant traverses this rejection based upon *Herberger* '266.

Chadbourne, U.S. Pat. No.613,652, Issued November 1, 1898

With reference to the *Chadbourne* '652 patent, said patent is directed to a stop cock box having a cap portion "a" (which the Examiner found readable on Applicant's hemispherical cap), a body portion "b" (which the Examiner found readable on Applicant's hollow body) and the lower portion of "b" (which the Examiner found readable on Applicant's bottom portion. *First Office Action*, P. 2, Par. 4.

Review of the elements cited by the Examiner, in light of the amended claims, now demonstrates that Applicant's device is clearly and patentably distinguishable from Chadbourne. Given Applicant's amendment, it is now readily apparent that the Chadbourne '652 device does not do the same work in the same manner as Applicant's device, for the same reason found in *Herberger* '266. Namely, the "body", "b" and lower portion of "b" (arguably the analogue of Applicant's "bottom portion", does not completely engulf that which is to be kept snow free. In this case, Chadbourne '652 protects "e" and "f", the rough analogue of Applicant's "fire hydrant". However, the body and lower portion of the Chadbourne device do not come anywhere near, yet alone engulf, that which is to be protected. If one attempted to utilize the Chadbourne '652 device as specified by Applicant in his application, the body would be suspended in mid-

air, allowing snowfall to easily accumulate around the base of the fire hydrant. Chadbourne does not intend the lower portion of "b" to protect that which is engulfed, and it cannot be made to do so without redesigning the Chadbourne device with reference to Applicant's device.

Given the clarification of what Applicant considers to be his invention, Applicant traverses this rejection based upon *Chadbourne* '266.

Rausch, German Pat. No.692,547, Issued June 21, 1940

With reference to the *Rausche* '547 patent, said patent is directed to an encasement device, apparently protecting a valve. The Examiner believed that the device includes element "a", readable on Applicant's hemispherical cap, element "d", readable on Applicant's hollow body, and the lower portion of element "d", readable on Applicant's bottom portion. *First Office Action*, P. 2, Par. 5.

Review of the elements cited by the Examiner, in light of the amended claims, now demonstrates that Applicant's device is clearly and patentably distinguishable from Rausch. Given Applicant's amendment, it is now readily apparent that the Rausch '547 device does not do the same work in the same manner as Applicant's device. A very clear and patentably distinguishable element is now presented in Applicant's claims, said element being completely absent in Rausch '547. Rausch does not provide for hand "purchase portions". "Because the instant invention is essentially mushroom shaped with the cap

portion being basically hemispherical, the instant invention may be easily removed from over the fire hydrant by grasping the instant invention under the cap portion at what may be called hand purchase portions (16). That is, the portion of the instant invention on its exterior which is the underside of the cap portion, proximate to where the cap portion merges into the middle portion (3).” *Application*, P. 9, par. 30. Furthermore, while the Examiner believed the cap portion readable onto Applicant’s hemispherical cap portion, Applicant respectfully traverses this finding and states that the cap in Rausch does not provide for a device in which “[t]he overall form of the device may be essentially “mushroom” shaped.” *Application*, P. 7, par. 24. A review of the cap provided in Rauch shows that it is generally flattened, or “discoidal”. “It is believed that the generally hemispherical shape of the cap portion is preferred as snow which falls down upon the instant invention will be less likely to accumulate on the cap portion as gravity will tend to cause said snow to slide off the hemispherically shaped cap rather than simply accumulate upon it as would likely be the case with a cap portion being flattened or discoidally shaped.” *Application*, P. 10, par. 31.

Given the clarification of what Applicant considers to be his invention, Applicant traverses this rejection based upon *Rausch* ‘547.

None of the references cited by the Examiner contain the limitations found in Applicants’ device, nor do they do substantially the same work, in substantially the same way. However, to move the matter forward Applicant has amended the claims to clarify

the requirement for complete engulfment and hand purchase areas. The rejections proposed by the Examiner will now be traversed, on legal grounds.

LEGAL ARGUMENT

Herberger '266, Chadbourne '652 and Rausch '547

The Examiner has rejected Applicant's invention, under 35 U.S.C. 102(b). The Examiner has stated that *Herberger '266, Chadbourne '652 and Rausch '547* each include a hemispherical cap, a hollow body and a lower portion. Applicant's amendment of his claims overcomes these rejections and renders the invention patentably distinguishable from the prior art. Applicant now traverses these rejections on legal grounds.

"Rejection based on 35 U.S.C. 102(b)....can be overcome by:

- (1) Persuasively arguing that the claims are patentably distinguishable from the prior art; or
- (2) Amending the claims to patentably distinguish over the prior art."

MPEP, 706.02(b)

"An invention is anticipated when the prior art disclosure is identical in substance with it...It is necessary that all the elements of the invention or their equivalents be found

in one single structure or description, where they do substantially the same work in substantially the same way.” Antonius v. Kamata-Ri & Co., Ltd., 212 USPQ 379, 380 (1981), citing Diversified Products Corporation v. Sports Stores, Inc., 160 USPQ 458 (1968).

“Unless all of the same elements are found in exactly the same situation and united in the same way to perform the identical function in a single prior art reference there is no anticipation.” Rite-Nail Packaging Corp. v. Berryfast, Inc., 219 USPQ 104, 105 (1983), citing Jones v. Vefo Inc., 204 USPQ 535 (1979).

Applicant respectfully submits that the rejection of claims 1, 2 and 5, based upon 35 U.S.C. Section 102(b), should be withdrawn because Applicant amended these claims to demonstrate that his device includes the hemispherical cap portion, the device being sized and shaped to completely engulf the fire hydrant, and hand purchase areas.

As pointed out in the Factual Argument section above, the device of *Herberger* '266 is constructed to protect the upper portion of “p”, and is narrowly, circumferentially skirted by “r” in order to prevent access. The “cap” “a” is further pivotably connected to the body in order to provide access to the portion of “p” contained within the hollow body. In Applicant’s device, the hollow body includes the hemispherical cap and lower portion, all being sized and shaped to completely engulf the fire hydrant.

It would be physically impossible for the device disclosed in *Herberger* '266 to have its lower portion modified to completely engulf the entirety of “p”. Making such a

change would only be possible with recourse to Applicant's disclosure, and would require copying Applicant's claims. There would be no reason to make such a change without the motivation provided by Applicant. In fact, attempting to re-configure the device of *Herberger* '266 would at best result in an inoperative invention. The inclusion of the pivotable top portion in *Herberger* '266, combined with the narrow circumferential skirting of "r" demonstrates that the objective is to prevent unauthorized access to the uppermost portion of "p". There is absolutely no indication that it would be desireable, or even possible, to completely engulf "p" in order to prevent the unwanted build up of snow around the base of "p". If one tries to read *Herberger* '266 include a claim to a hollow body being sized and shaped to completely engulf "p" (the fire hydrant of Applicant's invention), one would end up with an inoperative device. And it is a well established legal principal that "...a claim which is so broad as to include an inoperative embodiment is invalid. The rule as been construed either of two ways: if the claim is so broad as to cover an inoperative invention, it is either (1) invalid or (2) construed to cover only the operative embodiment." Chisholm-Ryder Co., Inc. v. Mecca Bros., Inc, et al. 217 USPQ 1322, 1337 (1983). Applicant believes that *Herberger* '266 must be given an interpretation which results in an operative invention, and such an interpretation cannot include the device being sized and shaped so as to completely engulf "p" (the fire hydrant analogue).

Chadbourne '652 is no longer a necessary grounds for rejection either, given Applicant's amendment. The "lower portion" of "b" in *Chadbourne* fails to engulf the lower portion of the stopcock ("h" and "e") and therefore cannot prevent the accumulation of snow about them. As noted above in connection with *Herberger*'266, even if one were to modify the lower portion of "b", the device would become unusable for their intended purpose. As with *Herberger* '266, the modification of *Chadbourne* '652 to engulf the device to be protected from the accumulation of snow (the fire hydrant) is an interpretation which would be impermissible under Chisholm-Ryder Co., Supra.

Finally, *Rausch* '547 fares no better under this analysis. It entirely lacks the hand purchase areas which make it possible to remove the fire hydrant cover from the fire hydrant after snow has built up in the adjacent area. Furthermore, it entirely lacks the overall "mushroom" shape and hemispherical cap portion which ultimately produces the "snow free area" which simplifies removal of Applicant's device from a fire hydrant. The device disclosed by *Rausch* '547 is nearly cylindrical in form. Applicant specifically eschewed such an approach. "As the snow falls, the cap portion (4) of the instant invention will tend to prevent the snowfall from accumulating proximate to the bottom portion (2) due to the fact that the overall shape of the instant invention includes the cap portion diameter (5) being greater than the bottom portion diameter (6). This accumulated snow (14) will therefore tend not to accumulate too closely around the bottom portion (2), making removal of the instant invention from up and off the fire

hydrant it engulfs much easier than if the device were merely cylindrical in shape. It should be quite apparent that by having the cap portion diameter (5) being greater than the bottom portion diameter (2) there will be a snow free area (15) extending radially from and around the instant invention. The snow free area should be approximately as great as the cap portion diameter (5)." *Application*, P. 9, par. 29, emphasis added.

And while the "[Rausch '547] patent is the closest prior art to the [Applicant's] inventions...this patent does not disclose the inventions of [Applicant] in full, clear, and exact terms that one skilled in the art could construct and practice...without having to use [Applicant's] teaching or some inventive skill." Medtronic, Inc. v. Catalyst Research Corp. 216 USPQ 687, 691 (1982) (Rausch '547 and Applicant inserted in place of original litigants, not part of original text).

Under the law as set forth in 35 U.S.C. Section 102(b), the differences identified in the Factual Argument and Legal Argument sections above support the withdrawal of the Examiner's rejections. "That which would *literally* infringe if later in time anticipates if earlier than the date of the invention." *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744 (Fed. Cir. 1987), *cert. Denied*, 484 U.S. 1007 (1988) (emphasis in original). Applicant takes the position that the amended claims of his invention would not be literally infringed by any of the cited art. None of the cited patents include any claims directed to Applicant's device, as now set forth in the amended claims. Therefore, Applicant

respectfully requests that the Examiner withdraw these grounds for rejection, and pass the application to speedy issuance.

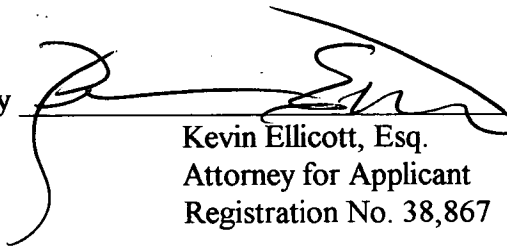
In light of the above amendments to the claims, Applicant respectfully requests that the Examiner remove the stated grounds for rejection. Applicant further requests that reconsideration of this application be given in light of the above amendments and that this application be allowed to issue.

Claims 1, 2 and 5 are now in the case. Claim 1 is independent. Therefore, no additional fee is due.

Respectfully,

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1. A fire hydrant protective cover and visibility marker comprising;
 - A. a hollow body having an interior space,
 - I. the hollow body being sized and shaped to completely engulf a fire hydrant,
 - II. the hollow body having hand purchase areas,
 - III. the hollow body having a bottom portion, a middle portion and a cap portion,
 - a. the bottom portion having an opening for accessing the interior space,
 - b. the bottom portion having bottom portion diameter
 - c. the cap portion being hemispherical in shape,
 - d. the cap portion having cap portion diameter,
 - i. the cap portion diameter being greater than the bottom portion diameter.
2. A fire hydrant protective cover and visibility marker according to claim 1, further comprising;
 - A. the bottom portion and middle portion being cylindrical in shape.
3. A fire hydrant protective cover and visibility marker according to claim 1, further comprising;
 - A. the middle portion having middle portion diameter,
 - I. the middle portion diameter being equal to the bottom portion diameter.